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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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7590 Barry E. Bretschneider Morrison & Foerster LLP Suite 300 1650 Tysons Boulevard McLean, VA 22102				
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EXAMINER				
STOREY, WILLIAM C				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/805,229

Applicant(s)

HASHIMOTO, YASUHIRO

Examiner

WILLIAM C. STOREY

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _____ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☐ Claim(s) _____ is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Claim Objections

1. Claim 15 is objected to under 37 CFR 1.75(a), which states that the specification must conclude with a claim particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention or discovery. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper form. In order to construe the same interpretation as previously directed before the amendment, the examiner assumes that the terminal is instructing and the printing section executing. In order to reduce any possibility over the ambiguity of whether the network may now be construed to perform these actions, the examiner suggests rewriting the claim limitations previously-referred in such a fashion: "a terminal connected to a network; the terminal for instructing" and "a printing section connected to the network; the printing section for executing printing."

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claim 1, 7, 8 14 and 15 is rejected under 35 U.S.C. 102(b) as being anticipated by Hamilton (US Patent 5715381).

Regarding claim 1, Hamilton discloses an image forming apparatus, comprising:
a template determination section for, upon reception of a job including a file to be

printed, determining whether or not the job contains a template which indicates that a plurality of files are to be merged; a job holding section for making the job stored in a storage section when it is determined by the template determination section that the job contains the template; a template analysis section for analyzing based on the template whether or not all jobs containing files to be merged are stored in the storage section; and a control section for exerting control based on the template so as to merge and print the files contained in all the jobs when it is determined by the template analysis section that all the jobs are stored in the storage section. Hamilton describes the printing controller, which reads on claimed template determination section; containing a multitude of packages. Packages contain jobs and it is well known in the art for jobs to direct a print process, which reads on job including a file to be printed; as disclosed at column 10, lines 3-4 and 8-9. Hamilton discloses that the jobs for printing may come from numerous sources, which reads on claimed reception; as disclosed in figure 10 and for example, column 9, lines 14-15. Properties of the package can be found by selecting "show package ticket" from a user interface, as disclosed at column 10, lines 23-25. The display will tell what properties have been determined, including options of embedded document first page merge item and embedded document last page merge item, which reads on claimed determining whether or not the job contains a template which indicated that a plurality of files are to be merged, as disclosed at column 11, lines 9-16. Hamilton discloses a local memory in the controller that may store packages and their contents, which includes jobs, which reads on claimed job holding section; as disclosed at column 11, lines 28-30. Hamilton also discloses that it

well known that jobs that are transferred and interpreted by a network printer, called decomposing jobs, store the jobs for output, which reads on claimed storing the job in a storage section when it is determined by the template determination section that the job contains the template; as disclosed at column 9, lines 16-25 and 32-35. Hamilton discloses that the jobs are stored for output and transferred to a print queue when ready for printing, as disclosed at column 9, lines 32-35. Hamilton discloses that embedded documents of a the network printer may be stored remotely, however, Hamilton provides a retrieve remote documents command for the purpose of retrieving one or more documents from a remote source to complete the package for purposes of printing the same at the local printer, as disclosed at column 12, lines 21-26. Hamilton discloses that when the user is ready to print, they copy the package to the printer queue for printing, as disclosed above. Hamilton discloses that when the destination is the printer queue, then a check is performed to determine if all of the jobs in the package to be copied are resident at the printing system. If all of the jobs are not resident, then a warning message is shown saying that not all jobs are local, as disclosed at column 15, lines 22-26. When all jobs for merging within a package are sent to the printer queue as above, this disclosure reads on claimed template analysis section for analyzing based on the template whether or not all jobs containing files to be merged are stored in the storage section. Hamilton discloses in figure 29, that when the jobs are all resident, flow proceeds down to 352, where formatting and printing occurs, which reads on a control section for exerting control based on the template so as to merge and print the files contained in all the jobs when it is determined by the template

analysis section that all the jobs are stored in the storage section. Hamilton discloses that printing goes job-by-job by a printing count when appropriate, disclosed in figure 29 and 31, and notes that when each job is attended to, the attendant image data and instructions are read, as disclosed at column 15, lines 45-47. An example of such instructions that may disclose finishing instructions is different bitmaps respectively positioned on the first and/or last pages of a plurality of jobs in a package, which reads on claimed merge; as disclosed at column 18, lines 10-12.

Regarding claim 7, Hamilton disclosed everything as applied above for claim 1. Hamilton discloses that the jobs for printing may come from numerous sources, which reads on claimed reception; as disclosed in figure 10 and for example, column 9, lines 14-15. This reads on claimed communication section for receiving jobs containing files to be printed via a network.

Regarding claim 8, claim 8 is rejected for the same reasoning as claim 1. Changing a claim from an apparatus to a method does not make that claim patentably distinct.

Regarding claim 14, claim 14 is rejected for the same reasoning as applied in claim 7. Changing from an apparatus to a method in a claim does not make the claim patentably distinct.

Regarding claim 15, claim 15 is rejected under many of the same reasoning as applied for claim 1, nay a few distinctions. Based on the previous disclosures of jobs being able to be sent over a network, network printing systems decomposing the jobs, and printing the jobs, this reads on claimed a terminal connected to a network for

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instructing a job containing a file to be printed and a printing section connected to the network for executing printing in response to an instruction or control. Hamilton discloses that the jobs for printing may come from numerous sources, which reads on claimed reception; as disclosed in figure 10 and for example, column 9, lines 14-15. This reads on claimed communication section for receiving jobs containing files to be printed via a network. Figure 10 points of the printing system's controller connected to a network, I/O apparatuses that may transfer jobs, and a printer. Any reference of network connection in the claim is thus read upon by the discussion above. The following paragraphs of the claim are rejected upon the disclosures of claim 1 in addition with the discussion and disclosures above.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2-4 and 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hamilton in view of Dimperio et al. (US Patent 6965445), hereinafter referred to as Dimperio.

Regarding claim 2, Hamilton discloses everything as applied above for claim 1. However, Hamilton fails to disclose the template contained in a job name. However, the examiner maintains that it was well known in the art to provide the template contained in a job name, as taught by Dimperio.

In a similar field of endeavor, Dimperio discloses systems and methods of automating job ticketing in printing, copying, or imaging devices. In addition, Dimperio discloses the use of file names that contain an embedded text and/or numerical string in order to correspond to a job ticket and outputting a document based on the job ticket instructions, which reads on claimed template; located in the file name, which reads on claimed job name; as disclosed in the claims.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hamilton by specifically providing the template contained in a job name, as taught by Dimperio, for the purpose of containing job instructions in a file name. Merging, as disclosed in the Hamilton reference, is a well-known job instruction.

Regarding claim 3, Hamilton discloses everything as applied above for claim 1. However, Hamilton fails to disclose the template as serial numbers set for over a plurality of the files. However, the examiner maintains that it was well known in the art to provide the template as serial numbers set for over a plurality of the files, as taught by Dimperio.

In a similar field of endeavor, Dimperio discloses systems and methods of automating job ticketing in printing, copying, or imaging devices. In addition, Dimperio discloses parameters, which reads on claimed template; of a job ticket defined as numerical values, which reads on claimed serial numbers; as disclosed in column 5, lines 4-8. One example of a possible parameter is page numbering, which reads on claimed set for over a plurality of pages; as disclosed at column 6, lines 40-41.

However, Dimperio discloses that any parameter may be described, as disclosed at column 6, 38-41.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hamilton by specifically providing the template as serial numbers set for over a plurality of the files, as taught by Dimperio, for the purpose of conveying templates in short codes.

Regarding claim 4, Hamilton and Dimperio disclose everything as applied above for claim 2. Dimperio disclosed above the use of strings, which read on claimed symbols; to convey different instructions to a printing system. Hamilton disclosed above that when a job is received at a printer, the printer instructs local storage for printing. Hamilton also disclosed above instructions for copying the jobs in a package to a print queue for printing. Both of these instructions are control commands that may be replicated. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hamilton by specifically providing the template composed of a pair of a first symbol indicating that a file contained in one job is temporarily stored in the storage section and a second symbol indicating that the files temporarily stored in the storage section are merged and printed, as taught by Dimperio, for the purpose of controlling a print system by file name instructions.

Regarding claim 9, claim 9 is rejected for the same reasoning as applied in claim 2. The method is inherent from an apparatus, thus does not make the claim patentably distinct.

Regarding claim 10, claim 10 is rejected for the same reasoning as applied in claim 3. The method is inherent from an apparatus, thus does not make the claim patentably distinct.

Regarding claim 11, claim 11 is rejected for the same reasoning as applied in claim 4. The method is inherent from an apparatus, thus does not make the claim patentably distinct.

5. Claims 5 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hamilton in view of well known prior art (MPEP 2144.03).

Regarding claim 5, Hamilton discloses everything claimed, as applied above (see claim 1); however, Hamilton fails to specifically disclose jobs containing all of the finishing techniques specified in claim 5. However, the examiner takes official notice of the fact that it was well known in the art to provide jobs containing all of the finishing techniques specified in claim 5, including specific print processing instructions such as double-sided printing, intensive printing, stapling or punching.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hamilton by specifically providing jobs containing all of the finishing techniques specified in claim 5, including specific print processing instructions such as double-sided printing, intensive printing, stapling or punching, for the purpose of being just other examples of job instructions of finishing techniques that may be actuated by the printing system of Hamilton.

Regarding claim 12, claim 12 is rejected for the same reasoning as applied in claim 5. The method is inherent from an apparatus, thus does not make the claim patentably distinct.

6. Claims 6 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hamilton in view of Dampiero and further in view of Suzuki.

Regarding claim 6, Hamilton and Dampiero disclose everything as applied above in claim 4. Dampiero and Hamilton disclosed above the use of a symbol to instruct printing of temporarily-stored files. However, Hamilton and Dampiero fail to disclose printing based on the last of a list of jobs. However, the examiner maintains that it was well known in the art to provide printing based on the last of a list of jobs, as taught by Suzuki (US Patent 5878196).

In a similar field of endeavor, Suzuki discloses a printer controller system. In addition, Suzuki discloses a job waiting in a reception waiting queue. When a job is received that contains the last of necessary documents for the job in the reception waiting queue, the waiting job is transferred to the printer queue for printing as disclosed at column 6, lines 7-11.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hamilton and Dampiero by specifically providing printing based on the last of a list of jobs, as taught by Suzuki, for the purpose of allowing full completion of an interrupted job or package.

As disclosed previously, a symbol can be used to instruct any set of instructions for a printing system, including the instruction of transferring associated files in associated jobs from one queue to another for printing. Hamilton discloses packages containing multiple jobs which contain multiple files. This idea of allowing full completion of an interrupted job or package could be transferred to the Hamilton scenario of transferring a package of jobs from the local storage to the printer queue once the last document of the last job has been locally stored with the symbol associated with the last document as previously mentioned that would direct the transfer. This idea and disclosure would reads on claimed printing of all the jobs is executed in compliance with a specific print processing instruction contained in a last received job among all the jobs.

Regarding claim 13, claim 13 is rejected for the same reasoning as applied in claim 6. The method is inherent from an apparatus, thus does not make the claim patentably distinct.

Response to Arguments

1. Applicant's arguments filed 2/19/2008 have been fully considered but they are not persuasive.

Regarding claim 1, the applicant claims that Hamilton does not specifically teach that a job is stored in a storage section when it is determined by the template determination section that the job contains the template. However, the disclosure provided for claim 1 discloses that Hamilton discloses that it was well known that jobs are transferred and interpreted by a network printer, called decomposing jobs, and store

the jobs for output in a job file, which reads on claimed making the job stored in a storage section when it is determined by the template determination section that the job contains the template; as disclosed at column 9, lines 16-25 and 32-35. The process of decomposing the jobs would realize that there is a template with instructions according to the data (see col. 1, lines 27-31 of Hamilton for additional reference) in order to create the job file. Thus, if information submitted to the printing system is determined to contain the template (instructions), then of course, as the procedure disclosed goes, the information would be stored for output in a job file, which is well known to contain the relevant "template" information; thus, necessitating that the template would have been determined to exist (or not) with the data transmitted to the printing system. The applicant does not claim that storage occurs "only when" it is determined that the job contains the template, but rather, that when it is determined that the job contains the template, i.e. when the job-related instructions and image data are captured, decomposed, and stored as a job file (which are known to contain data and instructions (which would contain the template (the information signifying merging))), the job is stored.

Regarding claim 2, the applicant claims a lack of motivation due to the fact that Hamilton already achieves the same result of Dimperio. The examiner respectfully disagrees. The examiner recites a purpose for combination of being able to contain job instructions in a file name, which was well known to those of ordinary skill in the art according to the Dimperio reference, and provides for the reduction of error and time consumption in job creation (Dimperio, col. 2, lines 15-21). Additional support for the

connection, compatibility, and motivation between the reference may be found in the fact that the two references are of the same assignee (Xerox) and provide similar reference figures. Hamilton discloses the network printing system in fig. 1 that Dimperio bases his invention off as well, shown in fig. 2. The applicant claims that the addition of a "package" precludes the ability of Hamilton to be motivated with job creation and the advantages that go along with the addition of Dimperio's instructions in the file name improvement to the printing system commonly discussed above. However, the package is merely a "job" structure in itself that may act upon a collection of jobs, just as a job may act upon a collection of material. A job that is contained in a package may have its own merge instruction as well (as this is well known in the art, similar to other job specific instructions that may be reproduced for "package" job instructions). In addition, Hamilton specifically discloses job creation, such as in the manner of programming job instructions. Some job instructions are created offsite of the network printing system and sent over the network for the printing, and still others are programmed there at the network printing system. The common system of Hamilton and Dimperio disclose a job programming application such as Paper UI to program job instructions (Hamilton col. 9, lines 47-49, Dimperio col. 3, lines 1-15). In addition, a nearly exact replica of the job programming interface is found in both Hamilton (fig. 9) and Dimperio (Fig. 1), showing that they both would have similar concern with reduction in time and error that may be provided by the use of file name instruction provided by Dimperio instead of the manual entry of job programming instructions through the interface mentioned. Dimperio disclosed that the user had to program different parameters (such as a merge function

shown in the figures) and enter different inputs for each job created, or programmed. This repetition by a user could lead to natural human error and of course, time consumption. The use of having the job instructions contained in a file name would automate the job creation process by locating previously created, proven, and repeatable available job instructions. Since both inventors are concerned with at least a similar system and similar job creation interface (both seen from the reference figures), and due to the improvement that providing job instructions in a file name is well known to provide, it is evident that motivation would exist.

Conclusion

2. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **WILLIAM C. STOREY** whose telephone number is

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(571)270-3576. The examiner can normally be reached on Monday - Friday Eastern Standard Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, King Y. Poon can be reached on (571) 272-7440. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/William C Storey/
Examiner, Art Unit 2625

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